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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,523	11/03/1999	JOEL DONALD GRAY	100344-005-	1168

7590 05/29/2003  
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EXAMINER

ISABELLA, DAVID J

ART UNIT PAPER NUMBER

3738

DATE MAILED: 05/29/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

# Office Action Summary

Application N .

09/432,523

Applicant(s)

GRAY ET AL.

Examiner

DAVID J ISABELLA

Art Unit

3738

-- Th MAILING DATE of this communication appears on the cov r sheet with the correspondenc address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 37-39,41-43 and 45-54 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 45-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37,38,41,42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 37-39,41 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginn, et al or Bacich et al

Each of Ginn, et al and Bacich, et al discloses a surgical clamp comprising an elongate, one piece, malleable hollow shaft including a distal end and proximal end. The clamp further comprises a clamp assembly with first and second opposably movable jaws, a handle assembly and an elongate actuator disposed within the hollow shaft as claimed.

Contrary to applicant's arguments, clearly each of Bacich, et al and Ginn, et al disclose the apparatus as broadly claimed.

Art Unit: 3738

With respect to Ginn, et al, applicant's attention is directed to figure 14 and column 8, lines 53+. The embodiment shown in figure 14 is comprises the malleable rod 16 with a clamp disposed on the distal end with first and second movable jaws 164 and 166. Note, that shaft 16 is hollow with cables 171 for actuating the jaws disposed therein.

With respect to Bacich, et al, see column 3, lines 27+, column 8, lines 27+, column 10 and lines 1+.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-39, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire in view of either of Bacich, et al or Ginn, et al. McGuire discloses a surgical knife having a malleable shank. Bacich, et al and Ginn, et al teaches the equivalence between surgical tools such as knives, clamps, forceps, etc all used in combination with malleable shafts. To modify the instrument of McGuire to a clamp or forcep would have been obvious from the teachings of Bacich, et al or Ginn, et al as being substantially equivalent elements.

With respect to the rejection to McGuire in view of either Ginn, et al or Bacich, et al, examiner rejection merely replaces one surgical tool for another since Bacich, et al

Art Unit: 3738

and Ginn, et al teaches the doctrine of equivalence between the various surgical tools including knives, clamps, forceps. These tools are used in combination with malleable shafts. Therefor to modify the instrument of McGuire to a clamp or forcep would have been obvious to one with ordinary skill in the art as being substantially equivalent elements based on the teachings of either of Bacich, et al or Ginn, et al.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-39,41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Lucey, et al.

Claim 37 utilizes a open ended transitional phrase “comprising” which does not preclude more than one element in the overall device. The segment 40 of Lucey, et al as a substructure of the total device clearly anticipates the claim as broadly worded.

With respect to Lucey, et al, see column 3, especially lines 25+. Contrary to applicant’s arguments, the region of the slots provide the shaft with a malleable region. This shaft in combination with forceps would include the handle with movable arms 24 and 25.

***Conclusion***

Applicant's arguments filed 3/4/03 have been fully considered but they are not persuasive. See examiner's arguments in the body of the rejection.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DAVID J ISABELLA** whose telephone number is 703-308-3060. The examiner can normally be reached on **MONDAY-FRIDAY**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **CORRINE MCDERMOTT** can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned


Application/Control Number: 09/432,523

Page 6

Art Unit: 3738

are 703-305-3579 for regular communications and 703-305-3580 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



DAVID ISABELLA  
Primary Examiner  
Art Unit 3738

dji  
May 20, 2003